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OFFICE OF PETITIONS

In re Application of :
Shennib et al. :
Application No. 10/052,199 : ON PETITION
Filed: 16 January, 2002 :
Atty. Dkt. No. 022176-000610US :

This is a decision on the renewed petition to withdraw holding of abandonment, filed on 19 September, 2006.

This application became abandoned on 11 December, 2004, for failure to timely respond to Notice of Allowance and Fee(s) Due mailed on 10 September, 2004, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 18 April, 2006. The petition filed on 25 May, 2006, was dismissed on 19 July, 2006.

Petitioners assert, at the outset, that the Notice of Allowance mailed on 10 September, 2004, was never received.

A review of the record indicates no irregularity in the mailing of the Office communication mailed on 10 September, 2004, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.¹ For example, if a three-month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from

¹ M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

the mail date of the non-received Office action must be submitted as documentary proof of non-receipt of the Office action.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Petitioner has not provided the showing as required above.

Furthermore, the showing of record is that the Notice of Allowance and Fee(s) Due was mailed to Donald R. Greene, P.O. Box 12995, Scottsdale, AZ 85267-2995. On 13 September, 2004, however, a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address was filed, changing the correspondence Address to the address associated with Customer No. 20350, which is Townsend and Townsend and Crew, LLP, Two Embarcadero Center, Eighth Floor, San Francisco, CA 94111-3834.

As such, a question is raised as to whether petitioners were receiving mail at the address of record at the time the Notice of Allowance and Fee(s) Due was mailed. Petitioners must verify that they were, in fact, receiving mail at the correspondence address listed in the Notice at the time the Notice was mailed, and for a reasonable time thereafter. The showing of record leads to a conclusion that the Office action may have been lost after receipt at the address of record because petitioners were no longer receiving mail at that address, rather than being lost in the mail.

Any renewed petition must provide the required showing that petitioners were receiving mail at the address listed on the Notice of Allowance and Fee(s) Due at the time the Notice was mailed.

Accordingly, the showing of record is insufficient to warrant withdrawal of the holding of abandonment at this time.

With regard to petitioners' argument that they did not see the Notice mailed on 10 September, 2004, in PAIR at the time the petition filed on 25 May, 2006, was filed, such does not merit withdraw of the holding of abandonment. MPEP 103 states that the Image File Wrapper (IFW) is the official record of the application. As such, the showing of record is that said Notice was in fact mailed on 10 September, 2004, and, as such, the

application became abandoned for failure to respond to said Notice.

Lastly, petitioners' assertion "that the Patent Office itself deemed that the application was still pending on 10/17/05 as evidenced by the Supplemental Notice of Allowance (sic) mailed on 10/17/05" is not persuasive. 35 U.S.C. 151 states that the application shall be regarded as abandoned if the issue fee is not paid within three months of the mailing of the Notice of Allowance. As such, the showing of record is that the application became abandoned as a matter of law for failure to timely pay the issue and publication fees in response to the Notice of Allowance mailed on 10 September, 2004. The supplemental Notice of Allowability mailed on 17 October, 2005, did not set a new time period for payment of the issue and publication fees, and had no bearing on the due date for the issue and publication fees. No new Notice of Allowance and Fee(s) Due was mailed, and the fact that petitioners believe that a new time period for payment of the issue and publication fee(s) should have been set is not more persuasive than the showing of record in the official file. As such, the time period set forth in the Notice of Allowance mailed on 10 September, 2004, remained in effect.

As such, the showing of record is that the abandonment resulted from the failure to petitioners to respond to the Notice of Allowance and Fee(s) Due, mailed on 10 September, 2004 rather than an error on the part of the USPTO.

Therefore, the application is properly held abandoned.

The petition is again **DISMISSED**.

Petitioners are encouraged to consider the filing of a petition under 37 CFR 1.137(b) to revive the application.

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the date of this decision.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
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By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
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Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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